

Docket 59881
Serial No. 10/643,399

PATENT APPLICATION

REMARKS

This is in full and timely response to the initial Office Action on the merits dated July 13, 2004. Reconsideration and reexamination are respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendment, claims 1-7 and 12-14 have been canceled, claim 8 has been amended, and claims 15 and 16 have been newly added. Therefore, claims 8-11 and 15-16 remain in this application with claims 8 and 15 being independent.

IN THE CLAIMS:35 U.S.C. 103(a) Rejections:

Claims 1-14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Herman (US 3,938,831), Wood (US 5,511,980), Werzberger (US 5,951,298), and Burrows (US 6,217,405). Without admitting the propriety of these rejections, claims 1-7 and 12-14 have been canceled.

Claim 8 stands rejected over Werzberger ('298) in view of Burrows ('405). Neither Werzberger ('298) nor Burrows ('405) disclose a book including:

front and back covers having metallic elements positioned beneath respective first surfaces thereof, said metallic elements being configured to be magnetically drawn to corresponding magnets of said plurality of magnets of said display board when said front and back covers are positioned on said book receiving section. (claim 8, lines 9-13)

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Since the quoted language has been rejected in claims 2-3 as being unpatentable over Werzberger ('298), Burrows ('405), and Herman ('831), it is assumed that claim 8 is actually rejected over Werzberger ('298), Burrows ('405) and Herman ('831).

Even when considering this additional reference, however, the cited art does not
5 disclose or suggest the limitation contained in line 4 of claim 8: "said book and card receiving sections being separated from one another". Without admitting the propriety of the present rejection, lines 5-6 of claim 8 have been amended to further emphasize the separation between the book receiving section and the card receiving sections. In applicant's claimed invention as recited in claim 8, lines 5-6, magnets are positioned only beneath book receiving and card
10 receiving sections (page 4, line 13 and Fig. 4).

At the very least, there must be something in the prior art references, either singly or in combination, to suggest the desirability, and thus the obviousness, of the proposed combination of references. In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313, 315 (Fed. Cir. 1986). The cited references do not teach or suggest applicant's claimed invention, as neither
15 Werzberger ('298), Burrows ('405), nor Herman ('831), either singly or in combination, disclose, teach, or suggest "a display board having a book receiving section and at least one card receiving section, said book and card receiving sections being separated from one another" (claim 8, lines 3-4). These separate sections provide spatial indications as to the appropriate location of a book and cards (application page 4, lines 23-25, page 5, lines 11-21, Figs. 1-2, Fig.
20 5) and are an advantage never before experienced in the art and certainly not taught in the cited

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references. To further emphasize these spatial relationships, divider partitions 20 separate the sections.

Since neither Werzberger ('298), Burrows ('405), nor Herman ('831) disclose, teach, or suggest, either singly or in combination, separate book receiving and card receiving sections, it necessarily follows that they do not (and cannot) disclose, teach, or suggest "a plurality of magnets positioned beneath a top surface of said display board in said book receiving section and said at least one card receiving section" (claim 8, lines 5-6). In other words, magnets are not positioned beneath the entire top surface of the display board in the currently claimed invention, but rather only beneath a book receiving section and at least one card receiving section.

Because there is absolutely no suggestion in the prior art to separate the book receiving and card receiving sections (as currently recited in the present application) or to place magnets only beneath the book receiving and card receiving sections (as currently recited in the present application,) a § 103(a) rejection of claim 8 is not supported. As such, the applicant respectfully requests that the present rejection of claim 8 be withdrawn.

Even without the above argument, a § 103(a) rejection of claim 8 is not appropriate. Lines 16-18 of claim 8 clearly require the set of cards in the currently claimed invention to be "ordered such that said second set of distinctive markings are encountered in the same order as said first set of distinctive markings are encountered in said story text." The examiner has cited Werzberger ('298) in the rejection of substantially similar claim 7 but has failed to address the subject matter in claim 8, lines 16-18. It is assumed that the examiner's argument in rejecting claim 7 applies equally in the rejection of similar subject matter in claim 8.

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Although the examiner suggests that column 13, lines 44-56 of Werzberger ('298) discloses "The second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the text," the applicant respectfully disagrees. Column 13, lines 55-56 makes it clear that Werzberger uses an indexed scheme, as opposed to
5 applicant's same-ordered scheme.

The cited references do not disclose, teach or suggest applicant's claimed invention, as none of the cited references disclose, teach, or suggest an arrangement in which the second set of distinctive markings are encountered in the same order as the first set of distinctive markings are encountered in the text. This feature is certainly not taught in the cited references. As such,
10 the applicant respectfully requests that the present rejection of claim 8 be withdrawn. However, if the examiner chooses to maintain the present rejections, it is respectfully requested that he identify the particular disclosures in the cited art that are being relied upon to support the rejections. Based on the amendment and all remarks made above, the applicant believes that claim 8 should now be in condition for allowance, along with claims 9-11 which depend
15 therefrom, and such is respectfully requested.

Further, and without admitting the propriety of the present rejections, claim 15 has been newly added to specifically emphasize the separation of book receiving and card receiving sections upon the game board. Claim 15 also specifically recites that magnets are positioned only beneath book receiving and card receiving sections (as opposed to beneath other sections of
20 the game board. This is important so that cards will not be held inadvertently in unintended positions along the game board surface. The divider partitions 20 disclosed in the originally filed

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specification are also positively recited. Claim 15, therefore, should be in condition for allowance for all of the reasons advanced previously, along with claim 16 which depends therefrom, and such is respectfully requested.

Based on the amendments and all remarks made above, the applicant believes that
5 claims 8-11 and 15-16 should now be in condition for allowance, and such is respectfully requested. If the examiner has any suggestions that would place this application in even better condition for allowance, he is invited to contact the applicant's representative at the telephone number listed below.

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HARSHAW RESEARCH, INC.
Lawyer's Building
2nd & Main
P.O. Box 418
Telephone (785) 242-9500
Facsimile (785) 242-3308

Respectfully Submitted,



Dale J. Ream
Patent Reg. No. 45,798